

REMARKSPending claims

Claims 1-7, 9-18 and 28-29 are pending in this application. Claims 8, 19-27 and 30-55 have been canceled. Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

Priority

In the Office Action mailed July 29, 2003, the Examiner alleges that the present application is not eligible as a CON of the parent application because "...the claims present in this, 10/025,335, are not those originally present in the parent application." (Office Action of July 29, 2003 at page 2.)

Please note that the MPEP provides guidance as to Continuation Practice as follows:

At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, ***an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims*** and to establish a right to further examination by the primary examiner. [emphasis added] (MPEP § 201.01.)

Additionally, the Office Action mailed July 29, 2003 asserts that claim 8 of the present application adds new matter not supported by the specification as filed (Office Action of July 29, 2003 at page 2). Applicants submit that claim 8 was inadvertently presented in the present application and is hereby canceled by this amendment. The issue of new matter in the present application is thereby rendered moot.

Applicants therefore submit that the present application is eligible as a CON of the parent application serial number 08/791,974, filed January 31, 1997 and respectfully request acknowledgment of same by the Examiner

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1, 2, 17 and 18) drawn to polypeptides or compositions thereof.

Group II (claims 3-7, 9, 12 and 13) drawn to polynucleotides, host cells and recombinant methods of producing the protein.

Group III (claim 8) drawn to transgenic animal.

Group IV (claim 11) drawn to antibodies.

Group V (claims 14 and 29) drawn to a method of detecting a hybridization complex.

Group VI (claim 16) drawn to a method of detecting a polynucleotide by PCR.

Group VII (claim 28) drawn to a method of screening expression-altering compounds.

Applicants hereby elect, with traverse, to prosecute Group II, which includes and is drawn to claims 3-7, 9, 12 and 13. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants suggest that Group I (claims 1, 2, 17 and 18), drawn to polypeptides or compositions thereof, and Group IV (claim 11) drawn to antibodies to the polypeptides, could be examined at the same time as the polynucleotides of Group II (claims 3-7, 9, 12 and 13) without undue burden on the Examiner, as a search of the prior art to determine the novelty of the polypeptides and antibodies would substantially overlap with the previously conducted searches of claims directed to the polynucleotides. Applicants respectfully submit that there is minimal additional burden on the Examiner to examine those claims in addition to the claims elected in the present application, particularly in view of the additional burden on Applicants to file, prosecute and maintain yet another application in this family, and respectfully request that the Examiner consider doing so.

Additionally, the method claims of Group V (claims 14 and 29), Group VI (claim 16) and Group VII (claim 28) are entitled to rejoinder upon allowance of any product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. §21.04 as follows.

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is

subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the entirety of Applicants' claims.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance. Early notice to that effect is earnestly solicited.

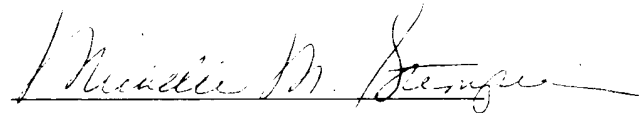
If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

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